

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK J. PELLEGRINO
and
ROBERT W. FLETCHER

Appeal No. 2001-0957
Application No. 08/581,992

ORDER REMANDING TO EXAMINER

On December 23, 1999, appellants filed an Appeal Brief (Paper No. 16). On March 14, 2000, the examiner entered an Examiner's Answer (Paper No. 17). The examiner states on page 4 of the Answer, first paragraph, that "[c]laims 1-19 remain rejected under 35 USC § 101 non-statutory matter. This rejection is set forth in prior office actions, Paper Nos. 2, 5, and 9." According to the Manual of Patent Examining Procedure (MPEP) § 1208(A) (7th ed., July 1998):

Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection appearing in a

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single prior action may be incorporated by reference.
An examiner's answer should not refer, either directly
or indirectly, to more than one prior Office action.

A review of the application reveals that the examiner refers to more than one single Office action when stating the grounds of rejection, namely, at least three Office actions. Therefore, the Examiner's Answer does not comply with the requirements set forth in MPEP § 1208(A).

Accordingly, it is

ORDERED that the application is remanded to the examiner in order to place the Examiner's Answer in compliance with the MPEP, or for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
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By: 

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July 26, 2002

Kimberly Jordan

It appears that in this case, although the opening paragraph in the Grounds for Rejection refers to "Paper Nos. 2,5 and 9" it goes on to state that the "rejection in the final action is as follows." It then repeats verbatim the rejection as stated in the Final rejection which was Paper No. 9. The complete rejection is in the Answer. The other papers 2 and 5, had the identical rejection and language.

Although it may appear to refer back to more than a single preceding action, in fact the statement of the grounds for rejection is complete in the Examiner's Answer and this is evident when reading the whole record.

As we discussed on the phone Thursday and Friday July 25 and 26, I am sending this back to you to see if you can clarify this matter in the record.

Thanks for your help.

A handwritten signature in black ink, appearing to read "Dave Mitchell", with a stylized, cursive script.

Dave Mitchell
QAS, TC 3600
703 308-0361